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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,458	01/28/2002	Mark J. Jaroszeski	0152.00429	4223
21901	7590	03/16/2004	EXAMINER	
SMITH & HOPEN PA 15950 BAY VISTA DRIVE SUITE 220 CLEARWATER, FL 33760			WEBER, JON P	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/058,458	JAROSZESKI ET AL.	
	Examiner	Art Unit	
	Jon P Weber, Ph.D.	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/4/02, 6/24/02</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

Claims 1-16 have been presented for examination.

Election/Restrictions

Applicant's election without traverse of Group II, claims 10-16 in the Paper filed 06 January 2004 is acknowledged. Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse. It is suggested that the non-elected claims be canceled in response to this Office action to expedite prosecution.

Drawings

Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites “insert” which is vague and indefinite because it is not clear what is encompassed by this term. That is the metes and bounds are not clear. Further, the definition offered in the disclosure is insufficient to limit the instant claims. While claims must be "given the broadest reasonable interpretation consistent with the specification", "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." *In re Prater* , 162 USPQ 541, 550 -51 (CCPA 1969). This is impermissible importation of subject matter from the specification into the claim.

Claim 13 recites “self-curing and curable agents” which is vague and indefinite because the metes and bounds let alone the meaning of these terms are unclear. The mere mention of these terms in the disclosure along with the assertion that these are known in the art fails to clarify what is being claimed.

Claim 14 recites that the fusion takes place prior to the cells being introduced into the chamber, which lacks clear antecedent basis. It would appear impossible to have a chamber for fusion for which the cells have already been fused.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaroszeski et al. (1994, Biophys. J), Stelkrech et al. (DE 3505147) or Jaroszeski et al. (WO 9964581).

Jaroszeski et al. (1994, Biophys. J) disclose a cell fusion chamber having a multilayer substrate to which the cells to be fused are drawn by vacuum means, a cuvette, fluid contained therein during electrofusion, and electromagnetic fusion means (See Fig 6 and accompanying text) the electrodes are inserted inside the chamber.

Referring to the drawings, Stelkrech et al. (DE 3,505,147) disclose a "cuvette" chamber containing inserts, wherein the inserts have electrodes, membranes and porous support backings, a vacuum means for holding cells on the support, electrofusion medium during the process, and electromagnetic means for effecting fusion.

Claims 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaroszeski et al. (US 6,221,665) or Jaroszeski et al. (US 6,355,485).

Jaroszeski et al. (WO 9964581), Jaroszeski et al. (US 6,221,665) and Jaroszeski et al. (US 6,355,485) all have the same disclosure of an electrofusion chamber having a substrate, a fluid medium therein, a means for inducing migration of cells in said chamber and means for inducing fusion of at least a portion of the cells. The electrodes can be considered inserts.

The additional limitations of claims 11-16 are intended uses and methods of use of the device, and do not appear to materially change the structure of the device *per se*. The limitation "insert" is being given its broadest reasonable interpretation to mean anything inserted inside a cuvette, including electrodes, membranes, and frits as disclosed in the reference. The cuvette

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itself is broadly interpreted to mean nothing more than a rectangular or cylindrical shaped hollow container, such as those used in UV-VIS spectroscopy. No specific or special spatial relationship is required by the instant claims.

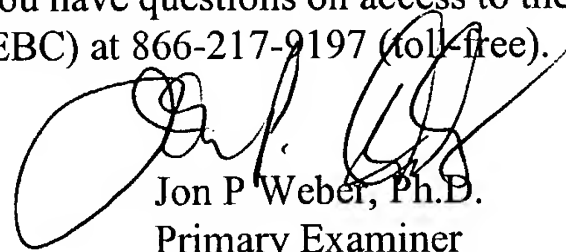
Other references cited by examiner but not relied upon are cited to establish the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 571-272-0925. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jon P Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
12 March 2004